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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SANCHAITA DATTA and RAGULA BHASKAR

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Appeal 2008-2737  
Application 10/034,190  
Technology Center 2400

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Decided: January 23, 2009

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Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and  
JAY P. LUCAS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-10 and 12-21. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

#### A. INVENTION

The invention at issue on appeal relates to the translation of domain names to IP addresses in a computer network, and more particularly relates to tools and techniques for distributing domain name resolution results among multiple connections, to provide benefits such as dynamic load-balancing across network connections and greater reliability. (Spec. 1.)

#### B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A connection-sensitive domain name resolution device,  
comprising:

a data component identifying IP addresses for at least two paths to a server which has a domain name; and

a code component which receives a domain name resolution request specifying the domain name, selects an IP address from the data component based on information about the status of a path to the server, said information obtained at least in part by pinging a router on a path to the server to determine if the router is a reliable connection component, said IP address selection made without regard to the router's proximity to the server, and supplies the selected IP address in response to the domain name resolution request.

#### C. REFERENCES

The Examiner relies on the following references as evidence:

Mogul	US 6,262,987 B1	Jul. 17, 2001
Vaid	US 6,502,131 B1	Dec. 31, 2002 (filed Dec. 4, 1998)
Zisapel	US 6,665,702 B1	Dec. 16, 2003 (filed Dec. 20, 1999)

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1, 8, and 13 (and dependent claims 2-7, 9, 10, 12, and 14-21) stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 8, and 13 (and dependent claims 2-7, 9, 10, 12, and 14-21) stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-9, 12-16, 18-19, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zisapel in view of Bommareddy.

Claims 10 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zisapel in view of Bommareddy and further in view of Mogul.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zisapel in view of Bommareddy and further in view of Vaid.

## II. ISSUE

Have Appellants shown error in the Examiner's initial showing of a lack of Written Description for the claimed invention?

Have Appellants shown error in the Examiner's initial showing of a lack of enablement for the claimed invention?

Have Appellants shown error in the Examiner's initial showing of obviousness for the claimed invention?

## III. PRINCIPLES OF LAW

### 35 U.S.C. § 112, First Paragraph: Written Description

The determination of whether a patent meets the written description requirement is a “question of fact, judged from the perspective of one of ordinary skill in the art as of the relevant filing date.” *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64). “To fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003) (citations omitted). Our reviewing court has cautioned, however, that “[t]he disclosure as originally filed does not . . . have to provide *in haec verba* support for the claimed subject matter at issue.” *Id.* at 1364. “Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (citations omitted). Put another way, “the applicant must . . . convey with

reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*.” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The written description, although it need not include information that is already known and available to the experienced public, must be in sufficient detail to satisfy the statutory requirements, employing “[w]ords, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 405 F.3d 985, 987 (Fed. Cir. 2005) (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). Finally, “[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis.” *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995) (citation omitted).

### 35 U.S.C. § 112, First Paragraph: Enablement

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. *See United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988), *In re Stephens*, 529 F.2d 1343, 1345 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the

claimed invention. *See In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *See In re Marzocchi*, 439 F.2d 220, 223 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

*In re Marzocchi*, 439 F.2d at 224.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. *See In re Brandstadter*, 484 F.2d 1395, 1406 (CCPA 1973). In making the

determination of enablement, the Examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement<sup>1</sup> against evidence that the Specification is not enabling.

Thus, the dispositive issue is whether the Appellants' disclosure, considering the level of ordinary skill in the art as of the date of the Appellants' application, would have enabled a person of such skill to make and use the Appellants' invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the Examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the Examiner has not done.

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John*

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<sup>1</sup> The Appellant may attempt to overcome the Examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The Appellant may also submit factual affidavits under 37 C.F.R. 1.132 or cite references to show what one skilled in the art knew at the time of filing the application.



*Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. *See Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 689 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d at 631-33.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. *See In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985); *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Hence, Appellants' burden before the PTO is to prove that does not perform the functions defined in the claims. The Appellants have not come forward with any evidence to satisfy that burden. *Compare In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Ludtke*, 441 F.2d 660, 664 (CCPA 1971). Appellants' mere argument on pages of the brief and pages of the reply brief that does not disclose is not evidence. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

Before addressing the Examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. *See*

*SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to Appellants' claim to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claims, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. *Yale Lock Mfg. Co. v. Greenleaf*, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 396 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908); *Cimiotti Unhairing Co. v. American Fur Ref. Co.*, 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." *United States v. Adams*, 383 U.S. 39, 49 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See *In re Priest*, 582 F.2d

33, 37 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. *See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988). What we are dealing with in this case is the construction of the limitations recited in the appealed claims.

#### IV. ANALYSIS

##### 35 U.S.C. § 112, First Paragraph: Written Description

With respect to the written description rejection of each of the three independent claims, Appellants argue that the written description rejections are clearly erroneous as a matter of law because the level of ordinary skill in the art was not discussed, much less determined by the Examiner. Here, we find that the Examiner's lack of an express statement of the level of ordinary skill is not fatal to the written description rejection since in Appellants' arguments at pages 9 to 10 of the Brief clearly recognizes the level of skill in the relevant art with respect to Zisapel reference. Therefore, we address the Examiner's rejection based upon the Examiner's finding of fact that Appellants' Specification is silent as to the totality of disclosure with respect to the negative limitation. In the Examiner's Answer at pages 18-19, the Examiner addresses the Appellants' disclosure and the Examiner finds that no express support for the negative limitation "without regard to the router's proximity to the server." We agree with the Examiner that the exemplary discussions at page 10 of Appellants' Specification do not show that the Appellants had possession of every embodiment which would be covered by

the negative claim limitation. Therefore, we find Appellants' lacked written description support for each of the independent claims containing the negative limitation "without regard to the router's proximity to the server," and we sustain the rejection of independent claims 1, 8, and 12 and their respective dependent claims.

Appellants argue that the Examiner's written description rejection is further wrong on the facts. (App. Br. 9). Appellants argue that Zisapel sets forth what one of ordinary skill in the art would have been familiar with including hop count and geographic location proximity measures which were known to the person of ordinary skill in the art. (App. Br. 9). Appellants argue that one of ordinary skill in the art would understand that geographic location and hop count can be used to measure the proximity of the server and from Appellants' Specification at page 10, the skilled artisan would understand that these parameters are not required in every instance because hop count and geographic location are merely a preference as evidenced by the use of "such as" and "may." Appellants argue that one of ordinary skill would understand that IP address election may be made in some cases with regard to proximity and in other cases is made without regard to server proximity. (App. Br. 9-11). While we agree with Appellants' analysis, we disagree with Appellants' conclusion that the totality of all situations covered by the negative limitation are clearly disclosed and Appellants had possession thereof at the time the application was filed. If this were so, then the prior art teachings of Zisapel would necessarily teach and fairly suggest the claimed invention since they show and teach exemplary embodiments using proximity and others without.

Here, we find that Appellants have not shown error in Examiner's initial showing of a lack of written description for the negative limitation. Therefore, we will sustain the written description rejection of independent claims 1, 8, and 12 and their respective dependent claims.

35 U.S.C. § 112, First Paragraph: Enablement

With respect to the Examiner's rejection of each of the independent claims based upon a lack of enablement, we find that one of ordinary skill in the relevant art of domain name resolution would have been able to make and use the claimed invention without undue experimentation with respect to the negative limitation without regard to the router's proximity to the server. Therefore, we will not sustain the rejection of independent claims 1, 8, and 12 and their respective dependent claims.

35 U.S.C. § 103(a): Obviousness

With respect to the Examiner's rejection based upon obviousness, the Examiner maintains that the system of Zisapel teaches IP address selection "without regard to the router's proximity to the server" by using the F content function. (Ans. 8). Here, Zisapel teaches either the use of proximity or a second shortest route or in column 7 whereby proximity necessarily is not used as a determination factor. Additionally, Zisapel teaches the content Browder 508 presenting to the client 502 the most efficient pathway for choosing his connection to the destination 504 based upon a path quality factor Q1 and Q2 where the path quality factor is based upon a function of traffic load; packet loss; and link pricing which do not necessarily involve proximity to the server. Therefore, we agree with the Examiner that Zisapel

does not teach a requirement of the use of proximity and teaches and fairly suggests the use of many factors in the determination other than proximity.

Appellants further argue that the references were not properly combined in the rejection. (App. Br. 13-17). Appellants contend that the router clustering system of Bommareddy is not directed to domain name resolution and that the specific field of Bommareddy is not the same field of domain name resolution. Appellants opine that one who seeks to improve domain name resolution would not have been led to Bommareddy and to pick out one feature from among the dozens mentioned in Bommareddy. (App. Br. 15). Appellants contend that the pinging of the router to check the health is a central thrust of clustering routers as taught by Bommareddy. (App. Br. 16). We disagree with Appellants' contention and find that Zisapel teaches that managing of the router and by the content router typically depends on a number of factors including the availability of the path. One such manner determining availability is taught and fairly suggested by Bommareddy which is pinging the routers. Therefore, we do not find Appellants' argument of a lack of motivation or suggestion for the combination to be persuasive of error in the Examiner's initial showing of obviousness. Appellants argue that the use of the Bommareddy reference was driven by using the claims as a blueprint and to reconstruct Appellants claimed invention based upon hindsight reconstruction. (App. Br. 16). We disagree as discussed above and find sufficient motivation for the combination.

Appellants argue that Zisapel strongly teaches away from domain name resolution IP address selections which were based primarily or solely on the server or proximity. (App. Br. 17). Here, we disagree with

Appellants and do not find any specific "teaching away" in Zisapel. While Zisapel discusses proximity more than the other topics or factors, we find that there is not a specific teaching away from proximity and that it is only one factor which may be used or not used. Therefore, we do not find Appellants' argument to show error in the Examiner's initial showing of obviousness of independent claims 1, 8, and 12, and we will sustain the rejection thereof. Since Appellants have not set forth separate arguments for the patentability of the dependent claims, we will group those claims with their respective independent claims.

#### V. CONCLUSION

For the aforementioned reasons, Appellants have not shown that the Examiner erred in rejecting independent claims 1, 8, and 12 under written description. For the aforementioned reasons, Appellants have shown that the Examiner erred in rejecting independent claims 1, 8, and 12 under enablement. For the aforementioned reasons, Appellants has not shown that at the Examiner erred in rejecting independent claims 1, 8, and 12 under obviousness.

#### VI. ORDER

We affirm the written description rejection of claims 1-10 and 12-21; we reverse the enablement rejection of claims, 1-10 and 12-21; and we affirm the obviousness rejections of claims 1-10 and 12-21.



Appeal 2008-2737  
Application 10/034,190

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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